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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,223	07/27/2000	Gerald Francis McBrearty	AUS9-2000-0273-US1	1175

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International Business Machines Corporation
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EXAMINER

MAURO JR, THOMAS J

ART UNIT	PAPER NUMBER
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2143

DATE MAILED: 02/04/2004

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/627,223

Applicant(s)

MCBREARTY ET AL.

Examiner

Thomas J. Mauro Jr.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to the amendment of the application (Paper #4) filed on 11/27/2003. Claims 1-21 are presented for further examination.

Specification

2. The amended abstract of the disclosure is objected to because it contains the word "means" (Amendment, Page 2 line 9 of the Abstract). This constitutes legal phraseology and should be avoided. Correction is required. See MPEP § 608.01(b).

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 8 and 15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,098,102. Although

the conflicting claims are not identical, they are not patentably distinct from each other because both recite analogous methods to preselect and receive documents in a text-only mode.

Claim 1 of the present application recites a system for preselecting web documents to be downloaded in a text-only mode, while claims 1 and 2 of U.S. 6,098,102 recite preselecting hypertext document files types, i.e. graphics, to not be transferred during downloading, which provides a text-only document. While U.S. 6,098,102 does not explicitly mention Web documents, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply this to Web documents in order to allow preselecting over the Internet for these types of documents to occur.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 8 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, applicant recites, "said received hypertext Web documents" and later preselecting "received Web documents." This phrase is unclear and needs further clarification. Preselecting "received Web documents" is unclear because it is not known whether the documents have been received or not. For example, does this phrase mean that you are preselecting the text-only mode after you have first or previously received, i.e. downloaded, the

hypertext web document? Or, does this mean that you are preselecting the hypertext document that you are about to receive, i.e. download. The current claim language provokes multiple meanings to be interpreted and therefore needs clarification.

7. Claims 1-6, 8-13 and 15-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 1 recites the limitations "received hypertext documents" in line 4, "received hypertext Web documents" in line 9, "received Web document" in lines 13-14 and "received preselected Web documents" in line 17. Minimally, there is insufficient antecedent basis for the occurrence of "said received hypertext Web documents" recited in this claim. More importantly, these limitations are unclear due to the variations used within this claim and subsequently claims 2-6, 8-13 and 15-20. Please clarify the terms to make the claims clearer and more concise.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-2, 6-9, 13-16 and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Narayanaswami (U.S. 6,182,113).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

With respect to claim 1, Narayanaswami teaches a world wide web communications network with user access via a plurality of data processor controlled interactive receiving display stations for displaying received hypertext documents of at least one display page containing text and images, a system for reducing the downloading time of predetermined hypertext documents received from said Web comprising:

means at a receiving display station for downloading said received hypertext Web documents [Narayanaswami -- Col. 4 lines 6-9 and lines 13-18 -- Web browser, running on client PC, allows access to and downloads Web documents],

means enabling a user at said receiving display station to preselect received Web documents to be downloaded in a text-only mode [Narayanaswami -- Col. 5 lines 26-30 and Col. 6 lines 38-45 -- Bookmark scheduler allows user to enter bookmarks before viewing a website and define properties associated with a particular bookmark, i.e. text-only, either during given hours or with a given connection or all the time],

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means for determining whether a received Web document has been preselected for downloading in a text-only mode [Narayanaswami -- Col. 5 lines 26-30 – **Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have**], and

means responsive to said determining means for downloading such received preselected Web documents in a text-only mode [Narayanaswami -- Col. 7 lines 10-15 – **Document is downloaded based on criteria specified by the user, i.e. text-only**].

With respect to claim 2, Narayanaswami further teaches means for bookmarking selected received Web documents to thereby store at said receiving display station, direct links to the documents for future access [Narayanaswami -- Col. 4 lines 47-49 and lines 53-56 – **Bookmarks, including multiplexed bookmarks, can be stored by the user on the client PC**],

said bookmarking means including said means enabling the user to preselect said text-only mode to thereby enable the user to preselect whether the bookmarked Web document will be downloaded in a text-only mode when received [Narayanaswami -- Col. 5 lines 26-30 and Col. 6 lines 38-45 – **User defines events or criteria regarding the preselected bookmarks, i.e. text-only downloads for certain bookmarks, so that when accessed, page will be downloaded as specified by the user**].

With respect to claim 6, Narayanaswami further teaches a Web browsing means at said receiving display station including:

said means for bookmarking [Narayanaswami -- Col. 4 lines 47-49 and lines 53-56 – **Bookmarks, including multiplexed bookmarks, can be stored by the user on the client PC**], and

said means for determining whether a received Web document has been preselected for downloading in a text-only mode [Narayanaswami -- Col. 5 lines 26-30 – **Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. In addition, Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have**].

With respect to claim 7, Narayanaswami further teaches means at said receiving display station for storing said user's preselection of Web documents to be downloaded in a text-only mode [Narayanaswami -- Col. 4 lines 47-56 and Col. 6 lines 38-45 – **Bookmarks, stored at the client PC, contain user defined events, i.e. text-only mode, which will download a given bookmark or document in text-only mode**].

With respect to claims 8-9 and 13-14, these are method claims corresponding to the system claimed in claims 1-2 and 6-7. They have similar limitations; therefore, claims 8-9 and 13-14 are rejected under the same rationale.

With respect to claim 15, Narayanaswami teaches a computer program having code recorded on a computer readable medium for reducing the downloading time of predetermined hypertext documents of at least one display page containing text and images received at a web

display station [Narayanaswami -- Col. 4 lines 53-56 – System is implemented in browser or other software entity which, inherently, is comprised of instructions residing on the hard disk of the PC]. The remaining limitations of claim 15 are similar to the limitations of the method claimed in claim 1. Therefore, claim 15 is rejected under the same rationale.

With respect to claims 16 and 20-21, these are computer program limitations corresponding to the system claimed in claims 2 and 6-7. They have similar limitations; therefore, claims 16 and 20-21 are rejected under the same rationale.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 1 and 3 above respectively, in view of Duvall et al. (U.S. 5,884,033).

Regarding claim 3, Narayanaswami teaches the invention substantially as claimed, as aforementioned in claim 1 above, including preselecting sites through bookmarks to be downloaded in a text-only mode. Narayanaswami, however, fails to teach preselecting domains.

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Duvall discloses a filtering system which allows users to preselect families of URL's, i.e. domains to cause a given event to occur when a site from the family is selected **[Duvall -- Col. 7 line 5 and line 8]**.

Both Narayanaswami and Duvall are concerned with defining properties for given websites/family of websites, such that when accessed, the property associated with the site is executed.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the preselecting of domains for applying a given event or condition, as taught by Duvall into the invention of Narayanaswami, in order to provide a more efficient system such that users do not have to spend time entering their criteria for each site. In addition, it also provides that the system will be more efficient because it does not have to check if the specific site is listed, only if it belongs to a particular domain.

Regarding claim 4, Narayanaswami-Duvall teach the invention substantially as claimed, as aforementioned in claim 3 above, wherein said user is enabled to preselect web sites **[Narayanaswami -- Col. 4 lines 50-51 -- Bookmarks, which are specific URL's or websites, are preselected and entered into scheduler]** from which all received documents will be downloaded in text-only mode **[Narayanaswami -- Col. 5 lines 26-30 -- Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have]**.

Regarding claim 5, Narayanaswami-Duvall teach the invention substantially as claimed, as aforementioned in claim 3 above, a web browsing means at said receiving display station including:

said means for enabling a user at said receiving display station to preselect domains from which all received Web documents will be downloaded in a text-only mode [**Duvall -- Col. 7 line 5 and line 8 – System allows users to preselect families of URL's, i.e. domains to cause a given event to occur when a site from the family is selected**], and

said means for determining whether a receiving Web document has been preselected for downloading in a text-only mode [**Narayanaswami -- Col. 5 lines 26-30 – Bookmark scheduler allows users to enter bookmarks and define events, i.e. text-only periods. Scheduler allows a user to see the properties for a given bookmark to determine what properties it may have**].

13. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 8 and 10 above respectively, in view of Duvall et al. (U.S. 5,884,033).

Regarding claims 10-12, these are method claims corresponding to the system claimed in claims 3-5. They have similar limitations; therefore, claims 10-12 are rejected under the same rationale.

14. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narayanaswami (U.S. 6,182,113), as applied to claims 15 and 17 above respectively, in view of Duvall et al. (U.S. 5,884,033).

Regarding claims 17-19, these are computer program claims corresponding to the system claimed in claims 3-5. They have similar limitations; therefore, claims 17-19 are rejected under the same rationale.

Response to Arguments

15. Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nielsen et al. (U.S. 6,098,102) discloses a method of preselecting hypertext document file types to be downloaded, such that a text-only mode can be achieved by specifying

to not download graphic file types.

- Bodin (U.S. 6,223,224) discloses a method for downloading selected files from the Internet such that an aggregate virtual file is assembled which can be specified to be text-only.
- Phillips et al. (U.S. 6,487,588) discloses a method for preselecting whether graphics will be displayed or not on web page downloads, which if graphics are off, causes pages, that were preselected, to be downloaded in a text-only mode.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Mauro Jr. whose telephone number is 703-605-1234. The examiner can normally be reached on M-F 8:00a.m. - 4:30p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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TJM

January 27, 2004



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